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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,366	02/18/2000	Yoshinori Rokugo	040447/0210	8232

22428 7590 06/29/2004

FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

MEHRA, INDER P

ART UNIT	PAPER NUMBER
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2666

12

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,366

Applicant(s)

ROKUGO ET AL.

Examiner

Inder P Mehra

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 6/9/04 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/04 has been entered. which has been fully considered and made of record. Based on this amendment, claims 1-18 have been cancelled. Claim 19-36 have been added. Claims 19-36 are now pending.

Claim Objections

2. a. Claim 19 recites following limitation, "said one of said user devices" in lines 6 and 7. It lacks sufficient antecedent basis.

b. Claim 19 recites following limitation, "said one of said **plurality** of user devices" in line 12. It lacks sufficient antecedent basis.

c. Claim 35 recites "The VPI value" in line 1. It lacks antecedent basis.

Claim Rejections - 35 USC § 112

3. Claims 19-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19, 27 and 35 recite limitation, "when the device ID loaded in the second specific ATM cell is equal to the acquired device ID" in lines 16-17, which is not supported by specification.

Appropriate correction/clarification is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 19-22, 24-25, 27-30, 32-33 and 35-36 are rejected under 35 U.S.C. 102(a) as being anticipated by FRAAS et al (DE, PCT No. WO 99/07179, read with associated Chinese Patent Application 0105390.6 (CPEL0050415), hereinafter, CPEL.

For claims 19, 25, 27, 33 35, CPEL discloses, in reference to fig. 1, , " an ATM network system comprising:

- a network device, (KE);
- a plurality of user devices, (KS);
- wherein said network device receives a first specific ATM cell -----a specific VPI value and a specific VCI value ---identifier----from a user device and transmits a second specific ATM cell -----loaded with the identifier and a non-allocated VPI

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value (a proper VPI value) -----to said user device, refer to CPEL 'S page 1 lines 1-16;

- said user device acquires the identifier on first connection---and holds the non-allocated VPI value as the specific VCI value when the identifier loaded in the second specific ATM cell is equal to the acquired identifier, refer to CPEL 'S page 1 line 16-page 2 line 3;

For claims 20, 28, CPEL discloses, “ said user device ----confirmation means for transmitting a third specific ATM cell ----holding the proper value---fourth specific ATM cell ---in its header”, refer to CPEL page 2 lines 8-10;

“ said network device includes a confirmation response means for transmitting the fourth specific ATM cell in response to the third specific ATM cell “, refer to CPEL page 2 lines 10-15;

For claims 21, 24, 29, 32 and 36, CPEL discloses all the limitations of the subject matter including the limitation, “said user device includes an initialization means for initializing the proper VPI value-----fifth specific ATM cell ---loaded with an initializing request on an information field and receiving sixth specific ATM cell -----“; “ said network device ---transmission means----the sixth specific ATM cell in response to said fifth specific ATM cell”, refer to CPEL page 2 lines 16-20.

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For claims 22 and 30, CPEL discloses all the limitations of the subject matter including the limitation, "said user device ---initialization confirmation means ---seventh specific ATM cell ----identifier----eighth specific ATM cell --and non-allocated VPI value ----and acquired identifier, refer to CPEL page 3 lines 4-10.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23, 26, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over CPEL, as for claims 19 and 27 above, in view of **Shobatake** (US Patent No. 6,553,014).

For claims 23, 26, 31 and 34, CPEL discloses all limitations of subject matter, including limitation, "the proper VPI value is different from each other -----ATM cell", refer to CPEL page 3 lines 12-16), with the exception of the following limitations:

- "a number of said user devices connected with a channel of said network device is limited with a prescribed number", as taught by claims 23 and 31;
- "said network device has VPI value allocation memory table which includes-----VPI values every channel of network device, and flags for indicating whether the proper VPI value is allocated or not, as taught by claims 26 and 34;

Shobatake discloses, "a number of said user devices connected with a channel of said

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network device is limited with a prescribed number”, **as taught by claims 23 and 31**, (arbitrary number of terminals, refer to col.9 line55-col. 10 line 33) ;

Further, Shobatake discloses “said network device has VPI value allocation memory table which includes----- VPI values every channel of network device, and flags for indicating whether the proper VPI value is allocated or not, **as taught by claims 26 and 34**, (tag table and value of VPI/VCI, refer to col. 1 lines 50-60, col. 40 lines 40-53, (allocated flag, refer to col. 52 lines 26-40).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the capability of holding VPI value allocated by an ATM network device for communication by the user devices. The holding of VPI value can be implemented by combining/storing it into the table as taught by Shobatake. The suggestion/motivation to do so would have been to facilitate proper communication and ensure sufficient bandwidth.

Response to Arguments

8. Applicant's arguments with respect to claim19-36 filed 4/7/04 have been considered but are not persuasive.

In response to argument by applicant, “no such corresponding teachings are found in the prior art of record”, it is stated that new prior art, as provided in ‘IDS’ documents, such as, FRAAS et al (DE, PCT No. WO 99/07179, read with associated Chinese Patent Application 0105390.6 (CPEL0050415), hereinafter, CPEL, in view of **Shobatake** (US Patent No. 6,553,014) disclose all the limitations of all the claims, refer to this office action above.

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Further, applicant argues that claim 35 limitations are not obvious in view of the combined teachings of the prior art. Under new grounds of rejection, limitations of claim 35 are disclosed by CPEL' page 1 line 16-page 2 line 3.

Applicant argues that the cited reference (WO99/07179) is characterized by the use of the control signals such as SET UP for setting up a connection or RELEASE for releasing a connection as illustrated below in fig.. A.

In response it is stated that all limitations as anticipated by the prior art are functionally correct and read on the limitations of the claims.

Applicant's arguments regarding claims have been fully considered but they are not persuasive.

Conclusion

9. Any enquiry concerning this communication should be directed to Inder Mehra whose telephone number is (703) 305-1985. The examiner can be normally reached on Monday through Friday from 8:30AM to 5:00 PM.

If attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Seema Rao , can be reached on (703) 308-5463. Any enquiry of a general nature of relating to the status of this application or processing should be directed to the group receptionist whose telephone number is (703) 305-4700.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

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Washington, DC. 20231

Or faxed to (703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,
Arlington, VA, sixth floor (Receptionist).

Inder Mehra
Inder Mehra

June 24, 2004



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JUN 24 2004